

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of: Mason et al.

Group Art Unit: 2416

Serial No.: 09/627,253

Examiner: Nguyen, Toan D.

Filed: July 28, 2000

Docket No. 1322/40/2

Confirmation No.: 2388

For: PRESENCE REGISTRATION AND ROUTING NODE

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REQUEST FOR RECONSIDERATION OF PATENT TERM ADJUSTMENT

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

The notice of allowance indicates that the patent term adjustment (hereinafter "PTA") for this application under 35 U.S.C. § 154(b) is zero (0) days. Applicants respectfully request reconsideration of the PTA for this application under 35 U.S.C. § 154 (b)(3)((B)(ii). Favorable consideration is respectfully requested in view of the following statement of the facts in accordance with 37 C.F.R. § 1.705(b).

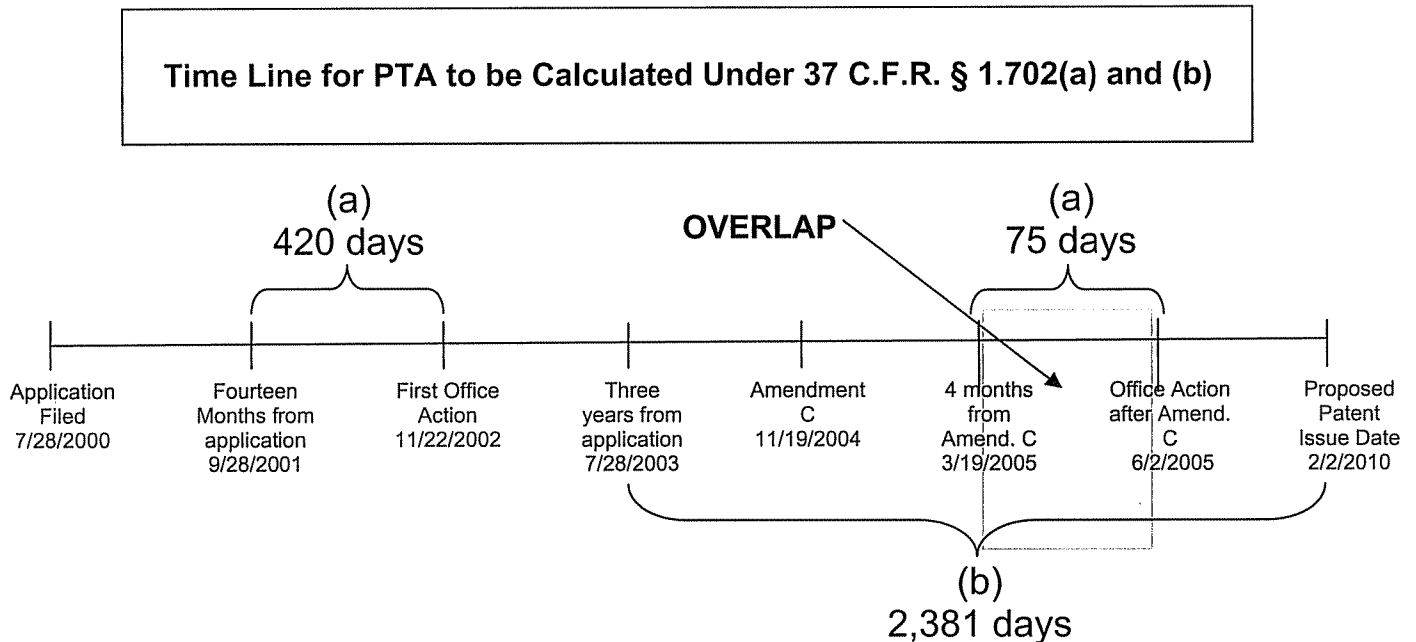
STATEMENT OF THE FACTS

Applicants filed utility patent application 09/627,253 on July 28, 2000 claiming priority to a provisional application filed on March 22, 2000. Applications filed on or after May 29, 2000 may have the patent term adjusted due to examination delay under the Patent Term Guarantee Act of 1999. (See 37 C.F.R. § 1.702). Adjustment of a patent's term is appropriate on two occasions. The first occasion is for the failure of the Office to take certain actions within specified time frames, and the second occasion is for failing to issue a patent within three (3) years of the actual filing date of the application. (See 37 C.F.R. § 1.702(a),(b) and 35 U.S.C. § 154(b)). Adjustments may be reduced by any overlap in credits for the two occasions, and for Applicants' failure to engage in reasonable efforts to conclude prosecution of the application.

Basis for the Correct PTA

The correct PTA for this application is believed to be 2,193 days. This number is calculated from a total of 2,909 days of PTA credit from the summation of 528 days of credit for the Office's failure to take certain actions within specified time periods under 37 C.F.R. § 1.702(a), and 2,381 days of credit for its failure to issue a patent within three years of the actual filing date of the application under 37 C.F.R. § 1.702(b). The calculated PTA credit of 2,909 days is reduced by the amount of any overlap between the periods of delay in 37 C.F.R. § 1.702(a) and (b). (See 35 U.S.C. § 154(b)(2)(A)). The overlap for this application was 75 days, as seen in the figure below. The 2,909 days of PTA credit is further reduced by 716 days for Applicants' response to office

actions outside of the three month time periods. (See 35 U.S.C § 154(b)(2)(C) and 37 C.F.R. § 1.704(a)).



Summary of Dates Used

The dates used in Applicants' calculations came from the application transaction history which is available on PAIR. The tables below shows the dates used, whether the dates correspond to a debit or a credit in days of PTA, and the basis for the adjustment. The total PTA in days is then calculated from the difference in value between the total credits and total debits available. Each is discussed below.

Applicants are entitled to a total of 2,909 days of PTA credit under the guarantees listed in 35 U.S.C. § 154(b)(1)(A) and (b)(1)(B). This credit is subject to reduction. The credit associated with adjustment for examination delays is calculated using 37 C.F.R. §§ 1.703(a)(1), (a)(2) and (b), which allows the term of the patent to be adjusted if the issuance of the patent was delayed due to the failure of the Office to mail

at least one notice of rejection or reexamination not later than fourteen (14) months from the date on which the application was filed, and for failure of the Office to respond to an applicant's reply not more than four (4) months after the date on which the reply was filed. The table of relevant dates below is in chronological order with the earliest date at the top of the table.

With respect to 37 C.F.R. § 1.703(a)(1), the relevant dates are the application filing date (July 28, 2000), fourteen months from the application filing date (September 28, 2001), and the first office action mailing date (November 22, 2002). According to 37 C.F.R. § 1.703(a)(1), the number of days credit allowed for this delay is counted beginning from the day after the date that is fourteen months after the application filing date and ending on the mailing date of the action or notice of allowance, whichever occurs first. The day after fourteen months from the filing date is September 28, 2001, and the first office action was not mailed until November 22, 2002. There are 420 days counted between September 28, 2001 and November 22, 2002. Thus, Applicants are entitled to a credit of 420 days for this delay.

With respect to 37 C.F.R. § 1.703(a)(2), the relevant dates are those dates where the Office took more than four months to mail an action or notice of allowance in response to a reply from the Applicants. In the instant case, this only occurred two times. Amendment C was filed on November 19, 2004 and the Office did not respond with a final Office Action until June 2, 2005. The rules allow an adjustment counted from the day after the date that is four months from Applicant's reply and ending on the date of mailing either an action or notice of allowance, whichever occurs first. The number of days from March 19, 2005 to June 2, 2005 is 75 days, to which Applicants

are entitled a credit. The other response from the Office which took more than 4 months was the mailing of an Ex Parte Quayle action on May 6, 2009 following Applicant's appeal brief filed on December 4, 2008. The number of days from the four month date of April 2009 to May 6, 2009 is 33 days, to which Applicants are entitled a credit. The summation of the aforementioned 420, 75, and 33 days is 528 days of credit.

With respect to 37 C.F.R. § 1.703(b), the period of adjustment is counted using the number of days beginning on the day after the date that is three years after the date on which the application was filed and ending on the date a patent was issued. Here, the patent has not yet issued, however, the credit can be calculated using the date provided in the Notice of Allowance as the Tuesday before the date that is 28 weeks (six and a half months) after the mailing date of the Notice of Allowance. The Notice of Allowance was mailed July 24, 2009. The Tuesday before the date that is 28 weeks after the mailing of the Notice of Allowance is February 2, 2010. Since the patent issue date is estimated to be February 2, 2010, and the date of three years from the application filing date is July 28, 2003, then counting the days in between these dates totals to 2,380 days. Therefore, Applicants are entitled to a credit of 2,381 days for the delay in the Office to issue a patent within three years of the application filing date.

Table 1: Calculation of PTA CREDITS					
<u>APPLICANT Action</u>	<u>USPTO Action</u>	<u>Date (From PAIR or Statutory)</u>		<u>Credits</u>	<u>Basis for Adjustment</u>
Application Filing			7/28/00		
		14 months	9/28/01		
	First Non-Final OA		11/22/02	420.00	37 C.F.R. § 1.704(a)(1), 37 C.F.R. § 1.703(a)(1), and 35 U.S.C. § 154 (b)(1)(A)(i)(I)

		3 years	7/28/03	2381.00	37 U.S.C. § 1.703(b) and 35 U.S.C. § 154(b)(1)(B)
Amendment C			11/19/04		37 C.F.R. § 1.704(b)
		4 months	3/19/05		
	Final OA		6/2/05	75.00	37 C.F.R. § 1.703(a)(2)
Appeal Brief			12/4/08		
		4 months	4/4/09		37 C.F.R. § 1.704(b)
	Ex Parte Quayle		5/7/09	33.00	
	Proposed Issue Date (from Notice of Allowance)		2/2/2010		
			SUM	2909.00	

The PTA calculated from the credits above, is reduced by a total of 716 days, thus entitling Applicants to a total PTA of 2,193 days or equal to:

$$\text{Total PTA (2,193 days)} = [\text{credits (2,909 days)} - \text{debits (716 days)}]$$

The rules reduce the period of adjustment of the patent term when an applicant fails to engage in reasonable efforts to conclude prosecution of the application. An applicant shall be deemed to have failed to engage in reasonable efforts to conclude processing or examination of an application for the cumulative total of any periods of time in excess of three (3) months that are taken to reply to any notice or action by the Office making any rejection, objection, argument or other request. (See 37 C.F.R. § 1.704(b)). This is also true with any supplemental paper, such as an Information Disclosure Statement (IDS) which is filed after an initial reply. (See 37 C.F.R. § 1.704(c)(8)). Here, Applicants shall be deemed to have failed to engage in reasonable efforts to conclude processing or examination on seven (7) occasions summarized in the table below. For example, the first occasion follows a non-final Office Action that was mailed on April 28, 2003. Applicants did not respond with Amendment B until September 29, 2003. This is more than three months after the non-final Office Action was mailed. Therefore, the period of PTA is reduced by the number of days beginning

on the day after the date that is three months after the date of mailing of the Office communication and ending on the date the reply was filed. Similarly, this occurred when Applicants filed Amendment C, a first Notice of Appeal, a Second Amendment B, a second Notice of Appeal, and two IDS. The total number of days resulting from Applicants' responses after the three month time periods, including the submission of supplemental papers is 641 days. Thus, the PTA credit calculated above shall be reduced by 641 days.

As discussed above, PTA is also reduced by any overlap in time granted under 35 U.S.C. § 154(b)(2)(A) and (b)(2)(B) times. An overlap occurred between the three year prosecution time period, and a time that the Office was later than four months to respond to Applicant's Amendment C. The 75 days of credit must be debited for the overlap, and when added to the aforementioned 641 days the total debit is 716 days. Therefore, Applicant's total PTA is reduced by 716 days as shown in the table below.

Table 2: Calculation of PTA DEBITS					
<u>APPLICANT Action</u>	<u>USPTO Action</u>	<u>Date (From PAIR or From Rules)</u>		<u>Debits</u>	<u>Basis for Adjustment</u>
Application Filing			7/28/00		
				75.00	Overlap between 3 year prosecution time period and examination delay- 35 U.S.C. § 154(b)(2)(A)
	NF OA		4/28/03		
		3 months	7/28/03		
Amendment B			9/29/03	63.00	37 C.F.R. § 1.704(b))
	NF OA		5/19/04		
		3 months	8/19/04		
Amendment C			11/19/04	92.00	37 C.F.R. § 1.704(b))
IDS			4/25/05	157.00	37 C.F.R. § 1.704(c)(8)
	Final OA		6/2/05		

		3 months	9/2/05		
Notice of Appeal			12/2/05	91.00	37 C.F.R. § 1.704(b))
	NF OA- re-open pros		8/25/06		
		3 months	11/25/06		
Notice of Appeal + pre-app req.			2/26/07	93.00	37 C.F.R. § 1.704(b))
	NF OA		9/20/07		
		3 months	12/20/07		
Amendment B			1/22/08	33.00	37 C.F.R. § 1.704(b))
IDS			3/12/08	50.00	37 C.F.R. § 1.704(c)(8)
	Final OA		4/4/08		
		3 months	7/4/08		
Notice of Appeal			9/4/08	62.00	37 C.F.R. § 1.704(b))
	Notice of Allowance		7/24/09		
Issue Fee Paid			10/24/09		
	Proposed Issue Date		2/2/2010		Six and 1/2 months from mailing date of notice of allowance
			Sum	716.00	

Terminal Disclaimer Not Applicable

An application for PTA must be accompanied by a statement of whether the patent is subject to a terminal disclaimer and any expiration date specified in the terminal disclaimer. (See 37 C.F.R. § 1.705(d)). As such, Applicants note that this application has not been subjected to a terminal disclaimer or any expiration date.

Relevant Circumstances Under 35 C.F.R. § 1.704

As discussed above, Applicants responded to the Office Action outside of the three month time periods on seven occasions summarized below:

- (1) Replying with Amendment B on 9/29/2003 following a non-final Office Action mailed 4/28/2003.
- (2) Replying with Amendment C on 11/19/2004 following a non-final Office Action mailed 5/19/2004.
- (3) An IDS filed on 4/25/05 after Amendment C.
- (4) Replying with a first Notice of Appeal on 12/2/2005 following a final Office Action mailed on 6/2/2005.
- (5) Replying with Amendment B on 1/22/2008 following a non-final Office Action mailed on 9/20/2007.
- (6) An IDS filed on 3/12/2008 after Amendment B.
- (7) Replying with a second Notice of Appeal on 9/4/2008 following a final Office Action dated 4/4/2008.

The dates of Applicants replies have been used in calculating the number of days by which the calculated PTA should be debited. Thus, Applicants are entitled to receive a total of 2,193 days of PTA.

CONCLUSION

In light of the above statement of the facts, it is respectfully submitted that the PTA please be reconsidered and adjusted accordingly.

DEPOSIT ACCOUNT


The Commissioner is hereby authorized to charge any fees associated with the filing of this correspondence to Deposit Account No. 50-0426.

Respectfully submitted,

JENKINS, WILSON, TAYLOR & HUNT, P.A.

Date: October 26, 2009

By:



Gregory A. Hunt
Registration No. 41,085
Customer No. 25297

1322/40/2

GAH/ECW/trb